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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,132	09/07/2001	Yves Chevallier	213512US0XPCT	7805

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EXAMINER
MUSSER, BARBARA J

ART UNIT	PAPER NUMBER
1733	4

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A94

Office Action Summary	Application No.	Applicant(s)	
	09/926,132	CHEVALLIER ET AL.	
	Examiner	Art Unit	
	Barbara J. Musser	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 1-3 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1. The references on the European search report have been considered but have not been made of record as no IDS listing the references has been sent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by self-adhesive as the final product does not have an adhesive outermost layer nor is the protective film required to be stripped.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerritsen(U.S Patent 4,658,548) in view of Clark(U.S. Patent 4,351,686), Strickland et al.(U.S. Patent 5,983,527) and Sawamura et al.(EP 0878285A1).

Gerritsen discloses a length of weatherstripping made of silicone rubber which has double sided tape attached thereto.(Col. 2, ll. 35; Col. 4, ll. 17-21) The reference

does not disclose how the strip is made or what the layers of adhesive in the double sided tape are. Clark discloses that silicone adhesives must normally be employed when applying adhesive to silicone rubber.(Col. 1, ll. 8-10) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the adhesive on the side of the double sided tape contacting the silicone rubber to be silicone adhesive since silicone adhesives are normally required for bonding materials to silicone.(Col. 1, ll. 8-10)

The references cited above suggests the weatherstripping is extruded(Col. 2, ll. 64-67) rather than injection molded. Strickland et al. discloses that injection molding a substrate against an adhesive results in a better bond than applying the adhesive to a preformed substrate(Col. 1, ll. 54-61) and does not require conditioning of the surface of the substrate prior to application of the adhesive.(Col. 1, ll. 16-18) It would have been obvious to one of ordinary skill in the art at the time the invention was made to injection mold the silicone rubber against the double sided tape of Gerritsen since this would result in a better mold and would not require conditioning of the silicone rubber prior to bonding(Col. 1, ll. 16-18, 54-61) and particularly since Sawamura et al. discloses silicone rubber can be injection molded to bond it to another layer.(Pg. 4, ll. 1-9) While Gerritsen does not disclose a release(protective) layer on the double sided tape, the use of release layers to prevent adhesive from bonding prior to its intended use is well-known and conventional in the art as shown for example by Strickland et al. which discloses having a release layer on the side of the adhesive facing the mold to prevent the adhesive sticking to the mold.(Col. 2, ll. 17-21) It would have been obvious to one

of ordinary skill in the art at the time the invention was made to apply a release layer to the side of the double sided tape which faces the mold wall since this would prevent it sticking to the mold and since the use of release layers for adhesive is well-known and conventional in the bonding arts as shown for example by Strickland et al.(Col. 2, ll. 17-21)

Regarding claim 2, while the references are silent as to the composition of the second adhesive layer(the other side of the double sided tape) Strickland et al. discloses that adhesive choice is dependent on the materials to be bonded together(Col. 2, ll. 14-16) and Clark discloses it is known to use a non-silicone based adhesive to bond a silicone based adhesive to another surface.(Col. 1, ll. 35-59) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the appropriate adhesive on the other side of the double sided tape such as a non-silicone adhesive when bonding to non-silicone materials since Strickland et al. discloses that the adhesive should be chosen depending on the materials to be bonded(Col. 2, ll. 14-16) and since Clark shows it is known to apply non-silicone adhesive to silicone adhesive to bond silicone rubber to other materials.(Col. 1, ll. 35-59)

Regarding claim 3, one in the art would appreciate that the label could be formed by a variety of methods such as applying the layers one at a time or by joining together films with adhesive only coated on them. Absent unexpected results this is considered obvious.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawamura et al.(EP 0878285A1) in view of Dornbusch et al.(U.S Patent 4,883,697).

Sawamura et al. discloses a method of applying a design to a silicone rubber article by applying to a mold a substrate comprising a design layer having a silicone based adhesive incorporated therein and a cover film, closing the mold, and injecting silicone rubber.(Pg. 4, ll. 1-9) It does not disclose the substrate being composed of a silicone-based adhesive layer, a film, a second adhesive layer, and a protective film. Dornbusch et al. discloses a method of applying a label to an object in a mold wherein the label comprises an adhesive layer, a film, a second adhesive layer, and a label.(Figure 5) This allows prevents wrinkling or deterioration of the label.(Col. 2, ll. 30-39) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the label of Dornbusch et al. in the process of Sawamura et al. since this would prevent wrinkling or deterioration of the cover sheet of Sawamura et al. One in the art would appreciate that since only silicone based adhesives can bond to silicone, the first adhesive layer contacting the silicone rubber would contain silicone-based adhesive components. A label is considered to be a protective film in that it protects the container from contact.

Regarding claim 2, Dornbusch et al. indicates the second adhesive layer is preferably a standard adhesive such as epoxy.(Col. 5, ll. 60-63)

Regarding claim 3, one in the art would appreciate that the label could be formed by a variety of methods such as applying the layers one at a time or by joining together

films with adhesive only coated on them. Absent unexpected results this is considered obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is **(703)-305-1352**. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BJM
February 13, 2003

Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700